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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,803	12/19/2000	Gary R. McLuen	NEI-00104	7285
28960	7590	12/15/2003	EXAMINER	
HAVERSTOCK & OWENS LLP 162 NORTH WOLFE ROAD SUNNYVALE, CA 94086			QUAN, ELIZABETH S	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/742,803	MCLUEN ET AL.	
	Examiner	Art Unit	
	Elizabeth Quan	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 27-30 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-30 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5 sheets</u> . | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Objections***

1. Claim 35 is objected to because of the following informalities: "hold" should be "hole."

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 27-30 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There appears to be no support maintaining a consistent flow through the bored interior during a flushing procedure by **only** forming a pressure differential to expel material from the vial.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 27-30 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Patent No. 3,215,500 to Bittner.

Bittner discloses a vial (10) comprising a bored interior, top opening (15), bottom opening, and exterior dimension (figs. 1-4). The bored interior has a consistent dimension configured to hold a frit (16) and maintain consistent flow through the bored interior during a flushing procedure by only forming a pressure differential to expel material from the vial (figs. 1-4; col. 1, lines 13-21 and 45-50; col. 2, lines 53-64; col. 3, lines 52-66). Note: The language “configured,” which is defined as to set up for operation especially in a particular way by Merriam-Webster Collegiate Dictionary, may be reasonably interpreted as being capable of, such that the prior art need not explicitly state that the bored interior holds a frit or consistent dimension of the bored interior maintains consistent flow through the bored interior during flushing procedure(s) by only forming a pressure differential to expel material from the vial. Additionally, the limitation “configured to hold a frit and maintain consistent flow through the bored interior during a flushing procedure by only forming a pressure differential to expel material from the vial” is a method limitation, which is accorded no patentable weight in apparatus claims. Materials are dispensed into the bored interior through the top opening (15) (col. 3, lines 11-14 and 34-39; col. 4, lines 12-16). The bottom opening is of a particular diameter to retain material within the bored interior when no pressure differential is applied and through which material is flushed during the flushing procedure (figs. 1-4). Note: The limitation “to retain material within the bored interior when no pressure differential is applied and through which material is flushed during the flushing procedure” is a method limitation, which is accorded no patentable weight in apparatus claims. The exterior dimension is configured to form a pressure-tight seal between the vial and a cartridge (18) when the vial is inserted into a receiving hole (21) of the cartridge (fig. 4; col. 3, line 73-col. 4, line 3). Note: The limitation

“configured to form a pressure-tight seal between the vial and a cartridge when the vial is inserted into a receiving hole of the cartridge” is noted. However, it is also noted that, as the structure of the device of Bittner is identical to that of the instant claims, the device of Bittner would inherently be capable of performing these functions.

6. Claims 27-30 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,874,691 to Chandler.

Chandler discloses a vial comprising a bored interior, top opening, bottom opening, and exterior dimension (figs. 4 and 5). The bored interior has a consistent dimension configured to hold a frit and maintain consistent flow through the bored interior during a flushing procedure by only forming a pressure differential to expel material from the vial (figs. 4 and 5). Liquid will flow through the frit with application of a pressure differential, such as a vacuum (figs. 4 and 5; col. 4, line 55-col. 5, line 12). Note: The language “configured,” which is defined as to set up for operation especially in a particular way by Merriam-Webster Collegiate Dictionary, may be reasonably interpreted as being capable of, such that the prior art need not explicitly state that the bored interior holds a frit or consistent dimension of the bored interior maintains consistent flow through the bored interior during flushing procedure(s) by only forming a pressure differential to expel material from the vial. Additionally, the limitation “configured to hold a frit and maintain consistent flow through the bored interior during a flushing procedure by only forming a pressure differential to expel material from the vial” is noted. However, it is also noted that, as the structure of the device of Chandler is identical to that of the instant claims, the device of Chandler would inherently be capable of performing these functions. Materials are dispensed into the bored interior through the top opening. The bottom opening is of a particular diameter to

retain material within the bored interior when no pressure differential is applied and through which material is flushed during the flushing procedure (figs. 4 and 5). The frit resists flow of liquid by gravity (figs. 4 and 5; col. 4, line 55-col. 5, line 12). Note: The limitation "to retain material within the bored interior when no pressure differential is applied and through which material is flushed during the flushing procedure" is a method limitation, which is accorded no patentable weight in apparatus claims. The exterior dimension is configured to form a pressure-tight seal between the vial and a cartridge/vacuum manifold when the vial is inserted into a receiving hole of the cartridge (fig. 5). One would expect that a pressure tight seal is formed between the vial and vacuum manifold in order to preserve the force of vacuum required to suck the material above the frit. The limitation "configured to form a pressure-tight seal between the vial and a cartridge when the vial is inserted into a receiving hole of the cartridge" is noted. However, it is also noted that, as the structure of the device of Chandler is identical to that of the instant claims, the device of Chandler would inherently be capable of performing these functions.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They include one or more limitations in the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Quan whose telephone number is (703) 305-1947. The examiner can normally be reached on M-F (8:00-4:30).

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Art Unit: 1743

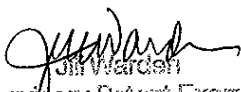
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (703) 308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Elizabeth Quan  
Examiner  
Art Unit 1743

eq

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700